

**REMARKS**

**I. Status of the Claims**

Claims 1, 4-9, 14-23, and 28-32 are pending and under examination. No claim amendments are presented herein.

**II. Foreign Priority Claim Under 35 U.S.C. § 119(a)**

Applicants are filing concurrently with this paper an English language translation of Applicants' foreign priority document, French Patent Application No. 03/03,000, along with a statement of accuracy signed by the translator. Applicants claimed foreign priority to French Patent Application No. 03/03,000 in the application transmittal letter filed on March 10, 2004. In addition, Applicants submitted a certified copy of the foreign priority application on March 10, 2004. Accordingly, Applicants submit that the claim of priority is perfected.

**III. Rejection Under 35 U.S.C. § 103(a)**

The Office rejects claims 1, 4-9, 14-23, and 28-32 under 35 U.S.C. § 103(a) as allegedly obvious over U.S. Patent Application Publication No. 2004/0161387 to Dupuis et al. ("Dupuis") in view of U.S. Patent No. 6,350,433 B1 to Ashton et al. ("Ashton") for the reasons set forth at pages 2-5 of the Final Office Action. According to the Office, Dupuis teaches a "hair composition compris[ing] 1% Luviset VPI K 61, 4% dimethylolpropionic acid/isophorone diisocyanate/neopentylglycol/polyesterdiols copolymer (Luvitec PUR), 40% . . . [but] lacks a teaching of a propellant comprising both dimethyl ether and at least one n-butane." *Id.* at 4-5. The Office brings in Ashton to

remedy this deficiency, alleging that it would have been obvious to one of ordinary skill in the art to combine Dupuis and Ashton "because Dupuis et al. teaches that a mixture of propellants may be used for delivering a polyurethane composition . . . [and] Ashton et al. teaches a composition that comprises carboxylated polyurethanes for hair fixing." *Id.* at 5.

Applicants respectfully traverse the rejection for the reason that the rejection is improper because Dupuis is disqualified as prior art under 35 U.S.C. § 103(c).

Applicants' application was filed March 10, 2004, and claims priority of French Patent Application No. 03/03,000, filed March 11, 2003, and U.S. Provisional Application No. 60/477,362, filed June 11, 2003. Applicants submit herewith a certified English translation of French Patent Application No. 03/03,000. A review of this English translation indicates that it meets all of the requirements of 35 U.S.C. § 112, and thus provides full support for the presently filed application. Accordingly, the instant application has an effective date of invention of March 11, 2003.

Dupuis, which published August 19, 2004, has an effective U.S. filing date of February 20, 2003. See M.P.E.P. 2136.03(I) ("[T]he foreign priority date of the reference under 35 U.S.C. 119(a)-(d) (f), and 365(a) cannot be used to antedate the application filing date."). Therefore, Dupuis appears only to be available as § 102(e) prior art.

While Dupuis qualifies as § 102(e) prior art, it is not available as prior art for an obviousness rejection against the current application, pursuant to 35 U.S.C. § 103(c). 35 U.S.C. § 103(c) states that subject matter that qualifies as prior art only under 35 U.S.C. §§ 102(e), (f), and/or (g) is disqualified as prior art against the claimed

invention if that "subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person." Common ownership may be established by a conspicuous statement indicating that the claimed invention and a § 102(e) reference were, at the time the invention was made, commonly owned or subject to an obligation of assignment to the same person. See M.P.E.P. § 706.02(I)(2)(II).

#### **STATEMENT REGARDING OBLIGATION OF ASSIGNMENT**

Dupuis is disqualified as prior art under 35 U.S.C. § 103(c), because the present invention and Dupuis were, at the time the invention was made, subject to an obligation of assignment to the same person, *i.e.*, L'Oréal S.A., as evidenced by the assignment information recorded for Dupuis on May 5, 2004, at Reel 015298, Frame 0871, and the assignment information recorded for the instant application on July 28, 2004, at Reel 015626, Frame 0380. See M.P.E.P. § 706.02(I)(2)(II). Accordingly, Applicants respectfully submit that the Examiner cannot rely upon Dupuis to support the pending § 103 rejection.

Accordingly, because Dupuis is not legally valid prior art against the present application, and Ashton does not teach or suggest all of the elements of the claims, Applicants respectfully submit that the Office failed to establish a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the rejection be withdrawn.

**IV. Conclusion**

In view of the foregoing remarks and Request for Continued Examination, Applicants respectfully request reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: 

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